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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,535	01/22/2002	Keith G. Copeland	97,008-X	7198

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EXAMINER
WARDEN, JILL ALICE

ART UNIT	PAPER NUMBER
1743	

DATE MAILED: 07/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/054,535	COPELAND ET AL.	
	Examiner	Art Unit	
	Jill A. Warden	1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 May 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *72-98* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *72-98* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

The information disclosure statement (IDS) submitted on March 24, 2003 was filed after the mailing date of the first Office action on October 30, 2002. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 103

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 72-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minekane in view of.

Minekane teaches an automatic chemical analysis apparatus including a plurality of separate reagents which are used in a plurality of different analysis reactions. The apparatus employs a reaction carousel which includes an annular of reaction cuvettes on the outer circumference and a plurality of reagent bottles inside the annular array. The apparatus includes a master control unit which includes information concerning each sample and different chemical tests to be performed on each sample as well as information on the content and location of the reagent bottles, which information has been input from "suitable data input means." Column 2, lines 19-34. Minekane specifically teaches that information on position and content of the reagent botteles is provided on bar codes affixed to the reagent bottles. Column 3, lines 60-65. Conventional reagent dispensers transfer reagent from the reagent bottles to the reaction cuvettes, and a sample dispenser can be employed to dispense sample into the reaction cuvettes.

Minekane does not teach employing slides instead of cuvettes, and employing barcodes on the slides.

The use of sample slides instead of reaction cuvettes is well known in the art. See, for example Azuma, et al. who teach employing chemical analysis elements (11) (i.e. sample slides) in an automated chemical analyzer. Azuma, et al. also teach that

the elements include a barcode (11a) which includes information on the type of test being performed on the slide. Column 3, lines 7-35. Azuma, et al. further teach that it is more conventional to use slides when employing dry chemical reagents. However, it is clearly appropriate to employ slides instead of cuvettes in order to lessen the amount of sample and reagents employed in the test.

It would have been obvious to one having ordinary skill in the art, to modify the apparatus of Minekane to employ slides with bar codes in place of the reaction cuvettes in order to minimize sample size, as well as employ dry chemistries. Such use of dry chemistries would not eliminate the use of reagent bottles, as other liquids, such as sample and wash liquids would still need to be provided to the slides. With respect to the barcodes, these would be considered "suitable data input means" as discussed in Minekane.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 72-98 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 6,352,861. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are broader in scope than those of U.S. Patent No. 6,352,861, as the patent claims include limitations specific to reading the bar code to determine dispensing requirements. As such, the patent claims anticipate the application claims. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

Response to Arguments

Applicant's arguments, see paper no. 9, filed May 6, 2003, with respect to the rejection of claims over Heidt et al. in view of Sakurada et al. have been fully considered and are persuasive. The rejection of claims 72-98 over these references has been withdrawn. However, a new rejection based on references filed with the IDS of March 24, 2003, as well as a rejection over applicants' patent, U.S. 6,352,861 have been entered.

Conclusion

Any inquiry concerning this communication should be directed to Jill A. Warden at telephone number (703) 308-4037.

Jill Warden
Supervisory Patent Examiner
Technology Center 1700